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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,284	11/23/1999	QINGHONG CAO	CAO-2-2-11-1	3630

7590 12/29/2004

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EXAMINER
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LY, NGHI H

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/447,284

Applicant(s)

CAO ET AL.

Examiner

Nghị H. Ly

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4,5,9,10,14,15,19,20,24,25,28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 9, 10, 14, 15, 19, 20, 24, 25, 28 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 2, 4, 5 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iyengar et al (US 6,546,241) in view of Rydbeck (WO 99/43136).

Regarding claims 1 and 29, Iyengar teaches a cordless telephone (see Abstract), comprising: a remote handset (see fig. 1, handset 109), a base unit matched to the remote handset (see fig. 1, handset 107), and an MPEG audio player integrated within at least one of the remote handset and the base unit (see column 5, lines 13-27,

Iyengar teaches MP3 or MPEG audio layer3 or MP3 is an abbreviation of MPEG audio layer 3) (also see column 1, lines 21-25).

Iyengar does not specifically disclose the remote handset can switch between performing as a telephony device and performing as audio player, the switching being initiated upon activation of a button on the remote handset of the cordless telephone.

Rydbeck teaches the remote handset can switch between performing as a telephony device and performing as audio player, the switching being initiated upon activation of a button on the remote handset of the cordless telephone (see page 7, lines 2-4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rydbeck into the system of Iyengar in order to prevent telephone conversation from interfering with audio sounds.

Regarding claim 2, Iyengar further teaches the MPEG audio player is integrated within the remote handset (column 5, lines 13-27, see "to the handset 109").

Regarding claims 4 and 5, Iyengar further teaches the MPEG audio player is an MP3 (column 5, lines 23-27, see "MP3").

4. Claims 14, 15, 24, 25 and 28 are rejected under 35 U.S.C 103(a) as being unpatentable over Iyengar et al (US 6,546,241) in view of Rostoker (US 6,035,212).

Regarding claims 14 and 24, Iyengar teaches a method of integrating an MPEG audio player in a cordless telephone (see column 5, lines 13-27, Iyengar teaches MP3 or MPEG audio layer3 or MP3 is an abbreviation of MPEG audio layer 3) (also see

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column 1, lines 21-25) comprising: connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (fig.1, see the connection between base unit 107 and network 100), playing MP3 music from a remote handset of the cordless telephone (see column 5, lines 13-27, Iyengar teaches MP3 or MPEG audio layer 3 or MP3 is an abbreviation of MPEG audio layer 3) (also see column 1, lines 21-25)

Iyengar does not specifically downloading digital bit stream music comprised in an MPEG format to the remote handset directly from a remote bit stream audio source, and is stored the downloaded digital bit stream music comprised in an MPEG format in the cordless telephone, wherein the downloaded digital bit stream music comprised in an MPEG format is stored in Flash memory in the remote handset.

Rostoker teaches downloading digital bit stream music comprised in an MPEG format to the remote handset directly from a remote bit stream audio source (see column 13, lines 20-24 and column 13, line 60 to column 14, line 4), and is stored the downloaded digital bit stream music comprised in an MPEG format in the cordless telephone (see column 9, line 29-31), wherein the downloaded digital bit stream music comprised in an MPEG format is stored in Flash memory in the remote handset (see column 9, line 29-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rostoker into the system of Iyengar in order to prevent data lost.

Regarding claims 15 and 25, Iyengar teaches a method of integrating an MPEG audio player in a cordless telephone (see column 5, lines 13-27, Iyengar teaches MP3

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or MPEG audio layer3 or MP3 is an abbreviation of MPEG audio layer 3) (also see column 1, lines 21-25) comprising: connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (fig.1, see the connection between base unit 107 and network 100), playing MP3 music from a remote handset of the cordless telephone (see column 5, lines 13-27, Iyengar teaches MP3 or MPEG audio layer3 or MP3 is an abbreviation of MPEG audio layer 3) (also see column 1, lines 21-25)

Iyengar does not specifically downloading digital bit stream music comprised in an MPEG format to the remote handset directly from a remote bit stream audio source (see column 13, lines 20-24 and column 13, line 60 to column 14, line 4), wherein the remote bit stream music comprised in a MPEG format to the remote handset via an Internet.

Rostoker teaches downloading digital bit stream music comprised in an MPEG format to the remote handset directly from a remote bit stream audio source (see column 13, lines 20-24 and column 13, line 60 to column 14, line 4), wherein the remote bit stream music comprised in a MPEG format to the remote handset via an Internet (see column 13, lines 20-24 and column 13, line 60 to column 14, line 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rostoker into the system of Iyengar in order to prevent data lost.

Regarding claim 28, Iyengar teaches a method of integrating an MPEG audio player in a cordless telephone (see column 5, lines 13-27, Iyengar teaches MP3 or MPEG audio layer3 or MP3 is an abbreviation of MPEG audio layer 3) (also see column

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1, lines 21-25) comprising: connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (fig.1, see the connection between base unit 107 and network 100), playing MP3 music from a remote handset of the cordless telephone (see column 5, lines 13-27, Iyengar teaches MP3 or MPEG audio layer3 or MP3 is an abbreviation of MPEG audio layer 3) (also see column 1, lines 21-25)

Iyengar does not specifically downloading digital bit stream music comprised in an MPEG format to the remote handset directly from a remote bit stream audio source, and for decompressing MPEG formatted music into digital music samples for digital to analog output.

Rostoker teaches downloading digital bit stream music comprised in an MPEG format to the remote handset directly from a remote bit stream audio source (see column 13, lines 20-24 and column 13, line 60 to column 14, line 4), and for decompressing MPEG formatted music into digital music samples for digital to analog output (see Rostoker, column 10, lines 45-52 and see column 14, lines 1-27).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rostoker into the system of Iyengar in order to prevent data lost.

5. Claims 9, 10, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iyengar et al (US 6,546,241) in view of Wingate (US 6,006,115).

Regarding claims 9, 10, 19 and 20, Iyengar teaches a method of integrating an MPEG audio player in a cordless telephone (see column 5, lines 13-27, Iyengar teaches

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MP3 or MPEG audio layer3 or MP3 is an abbreviation of MPEG audio layer 3) (also see column 1, lines 21-25) comprising: playing of the pre-loaded MP3 music from the remote handset of a cordless telephone (see column 5, lines 13-27, Iyengar teaches MP3 or MPEG audio layer3 or MP3 is an abbreviation of MPEG audio layer 3) (also see column 1, lines 21-25), connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (fig.1, see the connection between base unit 107 and network 100).

Iyengar does not specifically disclose muting the playing of the pre-loaded MP3 music when the remote handset is active in a current telephone call (see column 5, lines 13-27, Iyengar teaches MP3 or MPEG audio layer3 or MP3 is an abbreviation of MPEG audio layer 3) (also see column 1, lines 21-25).

Wingate teaches muting the playing of the music when the remote handset is active in a current telephone call (see column 4, lines 29-39).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Wingate into the system of Iyengar so that the user won't miss the telephone call while enjoy listening to music.

### ***Response to Arguments***

6. Applicant's arguments filed 08/12/2004 have been fully considered but they are not persuasive.

On page 8 of Applicant's remarks (dated 08/12/04), Applicant argues that



"Ivenqar is not available as prior art with respect to 35 USC 103(a), as Iyengar and the present invention were both owned, or subject to an obligation of assignment, by the same person. In particular, when the present invention was made (before the filing date of November 23, 1999), both Iyengar and the present invention were owned by LUCENT TECHNOLOGIES INC. (Note that subsequent to the filing of the present invention, LUCENT TECHNOLOGIES INC. spun off the group AGERE SYSTEMS INC., which continues to own both IYENGAR and the present invention".

The Examiner, however, disagrees. The filing date of this application is November 23, 1999, which is before November 29, 1999. Therefore, using **Iyengar** (US 6,546,241) (or owned by the same owner as stated by the Applicant) for the rejection 102/103 is proper. In addition, Applicant's attention is directed to the **MPEP 706.02(1)(1) Rejections Under 35 U.S.C. 102(e)/103; 35 U.S.C. 103 (c) [R-1]**.

### Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (703) 605-5164. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi H. Ly

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12/14/04

  
CHARLES APPIAH  
PRIMARY EXAMINER